



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,248	06/16/2006	Hirotaka Uosaki	1000023-000110	9104
21839	7590	10/02/2008	EXAMINER	
BUCHANAN, INGERSOLL & ROONEY PC			LE, HOA VAN	
POST OFFICE BOX 1404				
ALEXANDRIA, VA 22313-1404			ART UNIT	PAPER NUMBER
			1795	
			NOTIFICATION DATE	DELIVERY MODE
			10/02/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No.	Applicant(s)	
	10/583,248	UOSAKI ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-6,8 and 9 is/are rejected.
- 7) Claim(s) 7 and 10-13 is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>06/16/06</u> .	6) <input type="checkbox"/> Other: ____ .

This application is up for consideration on the merits.

I. Applicants' prior art submission has been considered to the extent of the English language as provided. Tsutsui et al ((4981605) is related to a polymer. The polymer is in a liquid form.

II. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yasuhiko et al (JP 04-055403 with a partial condition being supplied by applicants).

Yasuhiko et al disclose and teach polymers having a molecular weight of from 300, up to 80 mol% ethylene units and more than 1% of epoxy units as a fact.

Therefore, each of the polymers would have the properties. Please see the whole disclosure of the applied reference, especially in submissions of the Abstract and partial translation on at least the claims on page 1, on page 2 from “The present invention” to Examples. In addition, the language “density...”, “melting point...”, “epoxy group content...”, “molecular weight distribution (Mw/Mn)...” or the like is a property or a measurement property of a material and is given no patentable value for now over each of the applied polymers until applicants convincingly and timely shows or provide an evidence to the contrary for a timely consideration and examination to avoid a possibly, costly and timely litigation later on. For a patentability of the claimed property or measurement of the property of the material, it is allowed to request and require applicants to convincingly show or provide an evidence to the contrary for an early and timely consideration and examination to early allow the claims because the arguments alone are not a factual evidence. An allowed claim or patent would have no value when someone reasonably shows there is a possibly the same property using all possible combinations of the broad teachings and/or suggestions in the applied reference. Any evidence being not timely considered during the prosecution must be firstly considered and/or taken before any other issue is taken. One should look in to each of the issues because a benefit may be found and obtained. In the absence of

convincing evidence as early, timely and clearly pointed out and set forth on the record, since each of all property or measurement of the property in the claims has not been given any patentable value, it is reasonable that there would be at least one or more polymers being read on or within one or more of the claimed polymer. Accordingly, the above claims are reasonably found to be anticipated by Yasuhiko et al.

In an alternative, the broad teachings and/or suggestions and obviously about the same claimed property are applied. Accordingly, the above claims are reasonably found to be rendered prima facie obvious by Yasuhiko et al.

III. Claims 1 and 8-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yasuhiko et al (JP 04-055403 with a partial condition being supplied by applicants).

Yasuhiko et al disclose and teach polymers having a molecular weight of from 300, up to 80 mol% ethylene units and more than 1% of epoxy units as a fact. Therefore, each of the polymers would have the properties. Please see the whole disclosure of the applied reference, especially in submissions of the Abstract and partial translation on at least the claims on page 1, on page 2 from “The present invention” to Examples. In addition, the language “density...”, “melting point...”,

“epoxy group content...”, “molecular weight distribution (Mw/Mn)...” or the like is a property or a measurement property of a material and is given no patentable value for now over each of the applied polymers until applicants convincingly and timely shows or provide an evidence to the contrary for a timely consideration and examination to avoid a possibly, costly and timely litigation later on. For a patentability of the claimed property or measurement of the property of the material, it is allowed to request and require applicants to convincingly show or provide an evidence to the contrary for an early and timely consideration and examination to early allow the claims because the arguments alone are not a factual evidence. An allowed claim or patent would have no value when someone reasonably shows there is a possibly the same property using all possible combinations of the broad teachings and/or suggestions in the applied reference. Any evidence being not timely considered during the prosecution must be firstly considered and/or taken before any other issue is taken. One should look in to each of the issues because a benefit may be found and obtained. In the absence of convincing evidence as early, timely and clearly pointed out and set forth on the record, since each of all property or measurement of the property in the claims has not been given any patentable value, it is reasonable that there would be at least one or more polymers being read on or within one or more of the claimed polymer.

Accordingly, the above claims are reasonably found to be anticipated by Yasuhiko et al.

The language “is obtained” or “prepared” in a material claim is a product-by-process. It has been considered but has and is given no patentable value over each of the applied polymers until applicants convincingly show or provide an evidence that the claimed processing step is, in fact, always provide a patentably distinct chemical structures than each of those in applied reference and the distinct chemical structure is, in fact, always provide an unusual or unexpected result over each of those in the applied reference with respect to a wax property in a toner in a copying process. In the absence of convincing evidence as early, timely and clearly pointed out and set forth on the record, the above claims are reasonably found to be anticipated by Yasuhiko et al.

In an alternative, the broad teachings and/or suggestions and obviously about the same claimed property are applied. Accordingly, the above claims are reasonably found to be rendered *prima facie* obvious by Yasuhiko et al.

IV. Claims 1-6 and 8-9 are rejected under 35 U.S.C. 103(a) as obvious over Yasuhiko et al (JP 04-055403 with a partial condition being supplied by applicants) considered in view of Ishii et al (203/0027955).

Yasuhiko et al disclose and teach polymers having a molecular weight of from 300, up to 80 mol% ethylene units and more than 1% of epoxy units as a fact. Therefore, each of the polymers would have the properties. Please see the whole disclosure of the applied reference, especially in submissions of the Abstract and partial translation on at least the claims on page 1, on page 2 from “The present invention” to Examples. In addition, the language “density...”, “melting point...”, “epoxy group content...”, “molecular weight distribution (Mw/Mn)...” or the like is a property or a measurement property of a material and is given no patentable value for now over each of the applied polymers until applicants convincingly and timely shows or provide an evidence to the contrary for a timely consideration and examination to avoid a possibly, costly and timely litigation later on. For a patentability of the claimed property or measurement of the property of the material, it is allowed to request and require applicants to convincingly show or provide an evidence to the contrary for an early and timely consideration and examination to early allow the claims because the arguments alone are not a factual evidence. An allowed claim or patent would have no value when someone reasonably shows there is a possibly the same property using all possible combinations of the broad teachings and/or suggestions in the applied reference. Any evidence being not timely considered during the prosecution must be firstly

considered and/or taken before any other issue is taken. One should look in to each of the issues because a benefit may be found and obtained. In the absence of convincing evidence as early, timely and clearly pointed out and set forth on the record, since each of all property or measurement of the property in the claims has not been given any patentable value, it is reasonable that there would be at least one or more polymers being read on or within one or more of the claimed polymer. Accordingly, the above claims 1-6 are not found to be patentable over Yasuhiko et al.

Yasuhiko et al do not specify a catalyst in making a copolymer. However, it is known in the art at the time the invention was made to use the catalysts as those in claims 8 and 9 for making a copolymer. Evidence can be seen in at least Ishii et al on at least paragraphs 0008 to 0044.

Since the references are all related to copolymers and catalysts, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known catalyst for a reasonable expectation of being able to make a copolymer as disclosed, taught and suggested by Ishii et al.

V. Claims 1, 3-6 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yuji et al (JP 04-0004204 with a partial condition being supplied by applicants).

Yuji et al disclose and teach polymers having a molecular weight of from 300, ethylene units and more than 1% of epoxy units as a fact. Therefore, each of the polymers would have the properties. Please see the whole disclosure of the applied reference, especially in submissions of the Abstract and partial translation on at least the claims on page 1, on page 2 from “Means to solve the Problem” to whole page 3, Examples. In addition, the language “density...”, “melting point...”, “epoxy group content...”, “molecular weight distribution (Mw/Mn)...” or the like is a property or a measurement property of a material and is given no patentable value for now over each of the applied polymers until applicants convincingly and timely shows or provide an evidence to the contrary for a timely consideration and examination to avoid a possibly, costly and timely litigation later on. For a patentability of the claimed property or measurement of the property of the material, it is allowed to request and require applicants to convincingly show or provide an evidence to the contrary for an early and timely consideration and examination to early allow the claims because the arguments alone are not a factual evidence. An allowed claim or patent would have no value when someone

reasonably shows there is a possibly the same property using all possible combinations of the broad teachings and/or suggestions in the applied reference. Any evidence being not timely considered during the prosecution must be firstly considered and/or taken before any other issue is taken. One should look in to each of the issues because a benefit may be found and obtained. In the absence of convincing evidence as early, timely and clearly pointed out and set forth on the record, since each of all property or measurement of the property in the claims has not been given any patentable value, it is reasonable that there would be at least one or more polymers being read on or within one or more of the claimed polymer. Accordingly, the above claims are reasonably found to be anticipated by Yuji et al.

In an alternative, the broad teachings and/or suggestions and obviously about the same claimed property are applied. Accordingly, the above claims are reasonably found to be rendered *prima facie* obvious by Yuji et al.

VI. Claims 1, 3-6 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yuji et al (JP 04-0004204 with a partial condition being supplied by applicants).

Yuji et al disclose and teach polymers having a molecular weight of from 300, ethylene units and more than 1% of epoxy units as a fact. Therefore, each of

the polymers would have the properties. Please see the whole disclosure of the applied reference, especially in submissions of the Abstract and partial translation on at least the claims on page 1, on page 2 from “Means to solve the Problem” to whole page 3, Examples. In addition, the language “density...”, “melting point...”, “epoxy group content...”, “molecular weight distribution (Mw/Mn)...” or the like is a property or a measurement property of a material and is given no patentable value for now over each of the applied polymers until applicants convincingly and timely shows or provide an evidence to the contrary for a timely consideration and examination to avoid a possibly, costly and timely litigation later on. For a patentability of the claimed property or measurement of the property of the material, it is allowed to request and require applicants to convincingly show or provide an evidence to the contrary for an early and timely consideration and examination to early allow the claims because the arguments alone are not a factual evidence. An allowed claim or patent would have no value when someone reasonably shows there is a possibly the same property using all possible combinations of the broad teachings and/or suggestions in the applied reference. Any evidence being not timely considered during the prosecution must be firstly considered and/or taken before any other issue is taken. One should look in to each of the issues because a benefit may be found and obtained. In the absence of

convincing evidence as early, timely and clearly pointed out and set forth on the record, since each of all property or measurement of the property in the claims has not been given any patentable value, it is reasonable that there would be at least one or more polymers being read on or within one or more of the claimed polymer. Accordingly, the above claims are reasonably found to be anticipated by Yuji et al.

The language “is obtained” or “prepared” in a material claim is a product-by-process. It has been considered but has and is given no patentable value over each of the applied polymers until applicants convincingly show or provide an evidence that the claimed processing step is, in fact, always provide a patentably distinct chemical structures than each of those in applied reference and the distinct chemical structure is, in fact, always provide an unusual or unexpected result over each of those in the applied reference with respect to a wax property in a toner in a copying process. In the absence of convincing evidence as early, timely and clearly pointed out and set forth on the record, the above claims are reasonably found to be anticipated by Yuji et al.

In an alternative, the broad teachings and/or suggestions and obviously about the same claimed property are applied. Accordingly, the above claims are reasonably found to be rendered *prima facie* obvious by Yuji et al.

VII. Claims 1, 3-6 and 8-9 are rejected under 35 U.S.C. 103(a) as obvious over Yuji et al (JP 04-0004204 with a partial condition being supplied by applicants) considered in view of Ishii et al (203/0027955).

Yuji et al disclose and teach polymers having a molecular weight of from 300, ethylene units and more than 1% of epoxy units as a fact. Therefore, each of the polymers would have the properties. Please see the whole disclosure of the applied reference, especially in submissions of the Abstract and partial translation on at least the claims on page 1, on page 2 from “Means to solve the Problem” to whole page 3, Examples.

. In addition, the language “density...”, “melting point...”, “epoxy group content...”, “molecular weight distribution (Mw/Mn)...” or the like is a property or a measurement property of a material and is given no patentable value for now over each of the applied polymers until applicants convincingly and timely shows or provide an evidence to the contrary for a timely consideration and examination to avoid a possibly, costly and timely litigation later on. For a patentability of the claimed property or measurement of the property of the material, it is allowed to request and require applicants to convincingly show or provide an evidence to the contrary for an early and timely consideration and examination to early allow the claims because the arguments alone are not a factual evidence. An allowed claim

or patent would have no value when someone reasonably shows there is a possibly the same property using all possible combinations of the broad teachings and/or suggestions in the applied reference. Any evidence being not timely considered during the prosecution must be firstly considered and/or taken before any other issue is taken. One should look in to each of the issues because a benefit may be found and obtained. In the absence of convincing evidence as early, timely and clearly pointed out and set forth on the record, since each of all property or measurement of the property in the claims has not been given any patentable value, it is reasonable that there would be at least one or more polymers being read on or within one or more of the claimed polymer. Accordingly, the above claims 1-6 are not found to be patentable over Yuji et al.

Yuji et al do not specify a catalyst in making a copolymer. However, it is known in the art at the time the invention was made to use the catalysts as those in claim 9 for making a copolymer. Evidence can be seen in at least Ishii et al on at least paragraphs 0008 to 0044.

Since the references are all related to copolymers and catalysts, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known catalyst for a reasonable expectation of being able to make a copolymer as disclosed, taught and suggested by Ishii et al.

VIII. A showing should be submitted in the next response to this Office action in order for it to be considered timely.

IX. Claims 7 and 10-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status

information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoa V. Le/

Primary Examiner, Art Unit 1795

092608